

## PATENT COOPERATION TREATY

PCT

## NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

Assistant Commissioner for Patents  
United States Patent and Trademark  
Office  
Box PCT  
Washington, D.C.20231  
ETATS-UNIS D'AMERIQUE

in its capacity as elected Office

Date of mailing (day/month/year)

11 August 2000 (11.08.00)

International application No.

PCT/NL99/00743

Applicant's or agent's file reference

BO 42317

International filing date (day/month/year)

03 December 1999 (03.12.99)

Priority date (day/month/year)

04 December 1998 (04.12.98)

Applicant

VOS, Petrus, Antonius, Josephina et al

1. The designated Office is hereby notified of its election made:



in the demand filed with the International Preliminary Examining Authority on:

19 June 2000 (19.06.00)



in a notice effecting later election filed with the International Bureau on:

2. The election ☒ was

was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Facsimile No.: (41-22) 740.14.35

Authorized officer

Olivia RANAIVOJAONA

Telephone No.: (41-22) 338.83.38

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>BO 42317</b>	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. <b>PCT/NL99/00743</b>	International filing date ( <i>day/month/year</i> ) <b>03/12/1999</b>	Priority date ( <i>day/month/year</i> ) <b>04/12/1998</b>
International Patent Classification (IPC) or national classification and IPC <b>C12Q1/68</b>		
Applicant <b>KEYGENE N.V. et al.</b>		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.


2. This REPORT consists of a total of 9 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☒ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand  <b>19/06/2000</b>	Date of completion of this report  <b>06.02.2001</b>
Name and mailing address of the international preliminary examining authority:   European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized officer  <b>Barz, W</b>  Telephone No. +49 89 2399 7320



**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/NL99/00743

**I. Basis of the report**

1. This report has been drawn on the basis of *(substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments (Rules 70.16 and 70.17).):*

**Description, pages:**

1-55 as originally filed

**Claims, No.:**

1-30 as originally filed

**Drawings, sheets:**

1/10-10/10 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/NL99/00743

☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

### III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application.

☒ claims Nos. 30 (IA).

because:

☒ the said international application, or the said claims Nos. 30 (IA) relate to the following subject matter which does not require an international preliminary examination (*specify*):  
**see separate sheet**

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for the said claims Nos. .

2. A meaningful international preliminary examination report cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the standard.

☐ the computer readable form has not been furnished or does not comply with the standard.

### V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N) Yes: Claims 1-16, 18, 23-28

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/NL99/00743

	No:	Claims	17, 19-22, 29-30
Inventive step (IS)	Yes:	Claims	6-13, 15-16, 18, 25-28
	No:	Claims	1-5, 14, 17, 19-24, 29-30
Industrial applicability (IA)	Yes:	Claims	1-29
	No:	Claims	

2. Citations and explanations  
**see separate sheet**

## VI. Certain documents cited

1. Certain published documents (Rule 70.10)

and / or

2. Non-written disclosures (Rule 70.9)

**see separate sheet**

## VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:  
**see separate sheet**

## VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:  
**see separate sheet**

**ITEM III:**

Claim 30 relates to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(v) PCT. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of this claim (Article 34(4)(a)(i) PCT).

**ITEM V:**

Reference is made to the following document:

D1: WO 97 27317 A (AFFYMETRIX INC.), 31 July 1997; cited in the application.

**1. NOVELTY**

**Claims 17, 19-22, and 29-30** do not meet the requirements of Article 33(2) PCT for the following reasons:

- 1.1 Document D1 discloses a method for providing an array of nucleic acid sequences bound to a carrier, comprising all the steps of **claim 17** of the present application (page 79, line 3 - page 80, line 25; especially page 80, lines 23-25; figure 14). Therefore, the subject-matter of claim 17 is not novel in the sense of Article 33(2) PCT.
- 1.2 Similarly, arrays obtainable by the method of claim 17 are known from D1 (figure 14), thereby destroying novelty of **claim 19**.
- 1.3 Methods for analysing nucleic acid sequences, comprising hybridising said nucleic acids with an array of present claim 19, are also disclosed in D1 (page 80, lines 23-25; figure 14). Therefore, the subject-matter of **claims 20-22** is not novel in the sense of Article 33(2) PCT. It is drawn to the applicant's attention the expression "more specifically [...]" in claim 21 has no limiting effect, but is regarded as entirely optional (PCT Guidelines III-4.6).

- 1.4 The kits of parts comprising an array according to claim 19 is also known from D1 (claims 39-41), thereby destroying novelty of **claim 29**.
- 1.5 Finally, results or data obtainable by analysing a mixture of nucleic acids with an array according to claim 19 or by a method according to any of claims 20-22 are also disclosed throughout D1, thereby anticipating the subject-matter of **claim 30**.

## 2. INVENTIVE STEP

- 2.1 Document D1, which is considered to represent the closest prior art, discloses an array for analysing nucleic acid sequences comprising a carrier carrying at least two different DNA restriction fragments (page 80, lines 1-25; figure 14). Compared to D1, the subject-matter of **claim 1** differs only in that the nucleic acid sequences bound to the carrier correspond to restriction fragments obtainable by using at least one frequent cutter and at least one rare cutter restriction enzyme. The effect of said difference (i.e. the choice of one frequent cutter and one rare cutter) is the reduction of the size of the restriction fragments while, at the same time, targeting rare sequences (see page 13, lines 6-11, of the present application). The technical problem to be solved by the claim 1 may therefore be regarded as how to provide a array carrying nucleic acid fragments having a preferred size. However, in DNA fingerprinting, the choice of restriction enzymes which allow suitable fragments lengths falls within the scope of the customary practice followed by skilled persons, especially as the advantages thus achieved can readily be foreseen (see e.g. D1, page 78, lines 17-25). Therefore, it would be obvious to the skilled person to apply the choice of at least one frequent cutter and at least one rare cutter restriction enzyme to a DNA array according to D1, thereby arriving at an array according to claim 1. Therefore, the subject-matter of **claim 1** does not appear to involve an inventive step (Article 33(3) PCT).
- 2.2 The dependent **claims 2-5 and 14** do not contain any features which, in combination with the features of claim 1, meet the requirements of the PCT with respect to inventive step, because the additional features of these claims are also known from D1 (page 7, lines 9-14; page 9, lines 3-5 and 10-11; figures 1-5 and 15).

- 2.3 Compared to D1 (page 80, lines 23-25; figure 14), the method of present **claim 23** differs only in that the nucleic acids to be analysed comprise a mixture of restriction fragments obtained by using one frequent cutter and one rare cutter restriction enzyme. However, this difference cannot be considered inventive for the reasons outlined in item 2.1 above.
- 2.4 Similarly, the method of **claim 24** cannot be regarded as involving an inventive step, because the amplification of the target DNA prior to hybridisation with the array is also known from D1 (page 9, lines 21-25; page 81, figure 15).
- 2.5 In contrast, **claim 6** appears to involve an inventive step (Article 33(3) PCT) for the following reason: Compared to D1, the subject-matter of claim 6 differs by (i) carrier-bound sequences corresponding to restriction fragments obtainable by using at least one frequent cutter and at least one rare cutter restriction enzyme (see item 2.1 above) and (ii) said restriction fragments corresponding to AFLP-markers. While the first difference appears to be obvious to the skilled person (see above), the attachment of AFLP-markers to an array is neither disclosed nor suggested by the available prior art. Therefore, the skilled person would have no incentive to attachment such AFLP-markers to the carrier according to D1, thereby arriving at the subject-matter according to claim 6. Consequently, the subject-matter of claim 6 appears to involve an inventive step.
- 2.6 **Claims 7-12** are dependent on claim 6 and as such also meet the requirements of the PCT with respect to inventive step.
- 2.7 **Claim 13** seems to involve an inventive step for analogous reasons.
- 2.8 Similarly, the methods of **claims 15-16 and 18** appear to involve an inventive step for analogous reasons as outlined in item 2.5 above.
- 2.9 The method of **claim 25** seems to be inventive, because the available prior art does not appear to provide the skilled person with any hint to amplify the restriction fragments by AFLP.
- 2.10 Finally, the methods of **claims 26-28** also appears to be inventive.



**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/NL99/00743

**3. INDUSTRIAL APPLICABILITY**

The subject-matter of **claims 1-29** appears to be industrially applicable in the sense of Article 33(4) PCT.

**ITEM VI:**

Certain published documents (Rule 70.10)

Application No Patent No	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
WO 99/23256	14.05.99	30.10.98	30.10.97

The above patent document was published after the priority date, but before the filing date of the present application. Therefore, it is only relevant for those parts of the present application which do not have a valid claim to priority. Moreover, the above patent document may become relevant prior art in the Regional phase of the present application.

**ITEM VII:**

1. The incorporation of disclosures by reference (see passages on page 2, lines 8 and 18, page 3, lines 20-22, page 13, lines 10-11 and 17, page 16, line 30, page 17, line 2, and page 18) is not allowed (PCT Guidelines II-4.17).
2. In contrast to the requirements of PCT Guidelines II-4.18, the description refers to unpublished documents on page 3, line 20, and page 22, line 30.

**ITEM VIII:**

1. The terms "frequent cutter" and "rare cutter" used in **claims 1 and 23** are vague and unclear and leave the reader in doubt as to the meaning of the exact scope of

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

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International application No. PCT/NL99/00743

these features, thereby rendering the definition of the subject-matter of said claims unclear (Article 6 PCT; PCT Guidelines III-4.5).

2. **Claim 3** is unclear (Article 6 PCT), because the meaning of the expression "and corresponds with" is not apparent.
3. **Claim 13** is unclear (Article 6 PCT), because it relates to the "AFLP-markers" of claims 1-12, although claims 1-5 do not mention any AFLP-marker.
4. Similarly, **claim 24** is not clear, because it relates to "the mixture of restriction fragments" of claims 20-23, although claims 20-22 do not mention any such mixture.
5. Finally, **claim 26** is not clear (Article 6 PCT), because it relates to the AFLP-markers of the method of claims 20-25, although these markers are no essential feature of claims 20-24.

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference <b>BO 42317</b>	<b>FOR FURTHER ACTION</b>		see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.
International application No. <b>PCT/NL 99/ 00743</b>	International filing date (day/month/year) <b>03/12/1999</b>	(Earliest) Priority Date (day/month/year) <b>04/12/1998</b>	
Applicant  <b>KEYGENE N.V. et al.</b>			

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 3 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

**1. Basis of the report**

a. With regard to the language, the International search was carried out on the basis of the International application in the language in which it was filed, unless otherwise indicated under this item.

☐ the International search was carried out on the basis of a translation of the International application furnished to this Authority (Rule 23.1(b)).

b. With regard to any nucleotide and/or amino acid sequence disclosed in the International application, the International search was carried out on the basis of the sequence listing:

☐ contained in the International application in written form.

☐ filed together with the International application in computer readable form.

☒ furnished subsequently to this Authority in written form.

☒ furnished subsequently to this Authority in computer readable form.

☒ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the International application as filed has been furnished.

☒ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☐ Certain claims were found unsearchable (See Box I).

3. ☐ Unity of invention is lacking (see Box II).

**4. With regard to the title,**

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

**5. With regard to the abstract,**

☒ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this International search report, submit comments to this Authority.

**6. The figure of the drawings to be published with the abstract is Figure No.**

☐ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

☒ None of the figures.

# INTERNATIONAL SEARCH REPORT

International Application No.

99/00743

**A. CLASSIFICATION OF SUBJECT MATTER**  
IPC 7 C12Q1/68

According to International Patent Classification (IPC) or to both national classification and IPC

**B. FIELDS SEARCHED**

Minimum documentation searched (classification system followed by classification symbols)  
IPC 7 C12Q

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

**C. DOCUMENTS CONSIDERED TO BE RELEVANT**

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
Y	WO 96 17082 A (DU PONT ;MORGANTE MICHELE (IT); VOGEL JULIE MARIE (US)) 6 June 1996 (1996-06-06) the whole document	1-30
Y	WO 97 27317 A (CHEE MARK ;LAI CHAOQIANG (US); LEE DANNY (US); AFFYMETRIX INC (US)) 31 July 1997 (1997-07-31) cited in the application the whole document	1-30
A	WO 98 08981 A (LIFE TECHNOLOGIES INC) 5 March 1998 (1998-03-05) see whole doc. esp. claims 16 ff -/-	

☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

\* Special categories of cited documents :

- "A" document defining the general state of the art which is not considered to be of particular relevance
- "E" earlier document but published on or after the international filing date
- "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- "O" document referring to an oral disclosure, use, exhibition or other means
- "P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

"&" document member of the same patent family

Date of the actual completion of the international search

14 April 2000

Date of mailing of the international search report

25/04/2000

Name and mailing address of the ISA

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Authorized officer

Müller, F

## INTERNATIONAL SEARCH REPORT

International Application No

NL 99/00743

## C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category °	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	VOS P ET AL: "AFLP: a new technique for DNA fingerprinting" NUCLEIC ACIDS RESEARCH, 11 November 1995 (1995-11-11), XP002086756 cited in the application the whole document -----	
P,X	WO 99 23256 A (LUCITO ROBERT ;WIGLER MICHAEL (US); COLD SPRING HARBOR LAB (US)) 14 May 1999 (1999-05-14) see whole doc. esp. claims -----	1-30

# INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

NL 99/00743

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
WO 9617082	A	06-06-1996	AU 704660 B	29-04-1999
			AU 4367496 A	19-06-1996
			DE 69507646 D	11-03-1999
			DE 69507646 T	16-09-1999
			EP 0804618 A	05-11-1997
			JP 10509594 T	22-09-1998
			NZ 298236 A	28-01-1999
			US 5955276 A	21-09-1999
WO 9727317	A	31-07-1997	AU 2253397 A	20-08-1997
			EP 0880598 A	02-12-1998
WO 9808981	A	05-03-1998	AU 4174397 A	19-03-1998
WO 9923256	A	14-05-1999	AU 1449799 A	24-05-1999

## INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

P S 95/15150

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
EP-A-0534858	31-03-93	AU-B- 2662992	27-04-93
		CZ-A- 9400669	15-12-94
		WO-A- 9306239	01-04-93
		FI-A- 941360	24-05-94
		HU-A- 68504	28-06-95
		JP-T- 6510668	01-12-94
		NO-A- 941064	20-05-94
		ZA-A- 9207323	30-08-93
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WO-A-9118114	28-11-91	EP-A- 0530243	10-03-93
		JP-T- 5508313	25-11-93
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WO-A-9213969	20-08-92	US-A- 5364759	15-11-94
		AU-B- 1334392	07-09-92
		CA-A- 2101859	01-08-92
		EP-A- 0639228	22-02-95
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WO-A-9417203	04-08-94	AU-B- 5877194	15-08-94
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WO-A-9307166	15-04-93	CA-A- 2120525	15-04-93
		EP-A- 0666864	16-08-95
		JP-T- 7500244	12-01-95
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EP-A-0552545	28-07-93	AU-B- 3107493	22-07-93
		CA-A- 2085559	18-07-93
		HU-A- 69947	28-09-95
		JP-A- 7246099	26-09-95
		NZ-A- 245242	22-12-94
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WO-A-9515400	08-06-95	NONE	
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